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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,094	06/01/2001	Travis J. Parry	10005949-1	3103

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,094

Applicant(s)

PARRY ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-21, 23-31 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 9, 22 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 December 2005 has been entered.

Declaration under 37 CFR § 1.131

2. The declaration filed on 9 December 2005 under 37 CFR 1.131 is sufficient to overcome the Sato et al. reference (US 20010037267 A1).

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10-19, 21, 23-31 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulze, Jr. (US005483049A).
6. Schulze, Jr. teaches (independent claims 1, 10, 12, 17, 33 and 35) a method, apparatus and computer readable medium for rewarding a user for the consumption of consumables in an imaging device, the method comprising: detecting input of a *conventional coupon 36* (col. 3 line 65) by the *coupon exchange system 20* including a *coupon exchanger 32* (col. 3 lines

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63-64 and Figs. 1A and 1B), which reads on detecting consumption of a consumable (a *conventional coupon 36*) using a consumption detecting device (*coupon exchange system 20* containing *coupon sensor 132a*, col. 7 line 42); and when the input/consumption of a predefined quantity (e.g., one) of the consumable/*conventional coupon 36* has been detected, rewarding the user of the imaging device/*coupon exchange system 20* (by providing the user with a *coupon exchange coupon 40*, col. 3 lines 66-67).

7. Note on interpretation of claim terms Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”.
8. The instant application contains no such clear definition for the term “imaging device”. The term is supported by para. [0002] of the published spec. (US 20020194064A1), but that is example usage, and does not meet the requirements for a “clear definition.” In the instant case, the examiner is required to give the term “imaging device” its broadest reasonable interpretation, which the examiner judges to be any device that forms images. Indeed, that phrase is used in spec. para. [0002]. The *coupon exchange system 20* displays information (Fig. 3 and col. 5 lines 1-16) and prints *coupon exchange coupons 40* (col. 8 lines 18-37), both of which require forming images, so the *coupon exchange system 20* reads on an imaging device.
9. The instant application does contain a clear definition for the term “consumable”, at both published appl. para. [0002] and [0025]. The definition is broad, subsuming any input that, first, is needed to make an imaging device function. (“Generally, a consumable is any product used by an imaging forming device ...”, para. [0002]). Second, a “consumable” requires replenishment. The spec. definition of “consumable” in para. [0025] is further limited to a “portion” of an image-forming device, but that must be interpreted broadly

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because paper ("media on which an image is formed") is included by example. By this definition, a *conventional coupon 36* is a "consumable".

10. For independent claims 10 and 12, Schulze, Jr. teaches accepting input of virtually any *conventional coupon 36* (col. 2 lines 25-28), which reads on a plurality of consumables, and the "predefined collective quantity" is one coupon. For independent claim 17, Schulze, Jr. teaches data storage 92 (col. 6 lines 5-6) as the readable memory device storing the user reward message (i.e., the *coupon exchange coupon 40*).
11. Schulze, Jr. also teaches at the citations given above claims 2, 14, 26 and 36; claim 7, because everything in commerce has a price, which reads on a "standard retail price", and the user is getting the reward *coupon exchange coupon 40* for free, which is at a discount over the "standard retail price"; claim 11 (where the value of one consumable/*conventional coupon 36* unit is one reward/*coupon exchange coupon 40*); claims 13 and 18; claims 15 and 29, where sensing and accounting for the input coupon reads on calculating an estimated consumption; and claim 16.
12. Schulze, Jr. also teaches claims 6, 15, 23, 24, 30 and 35, where the "at least one identified source" is determined by whether or not the input coupon bears magnetic ink and the output from the *coupon discrimination unit 116* reads on a supplier identification signal (col. 7 line 16 to col. 8 line 17); claims 8, 21 and 31, where each *conventional coupon 36* reads on a sheet of media; and claims 3, 4, 19, 27 28 and 34 (col. 8 line 60 to col. 9 line 17), where the data used to verify the awarded *coupon exchange coupon 40* reads on a certificate verifying the award.
13. Claim 20 is rejected under 35 U.S.C. 103(a) as being obvious over Schulze, Jr. (US005483049A). Schulze, Jr. teaches a computer network communications device (*coupon exchanger 32*, col. 4 lines 13-19), but Schulze, Jr. does not teach that said device is an embedded web server. Because the WWW is commonly used to transmit the sort of digital data taught by Schulze, Jr., it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Schulze, Jr. that the computer network communications device/*coupon exchanger 32*, be or incorporate an embedded web server.

Potentially Allowable Subject Matter

14. Claims 9, 22 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art made of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
15. The following is an examiner's statement of reasons for the indication of allowable subject matter: the closest prior art, Schulze, Jr., does not teach or suggest that the consumable comprises an image forming substance.
16. Allowance is dependent on search of the foreign and non-patent literature, and approval by an allowance conference. The examiner has performed every search deemed reasonable, but does not ask for review of allowable subject matter until applicant indicates willingness to put the application in condition for allowance.

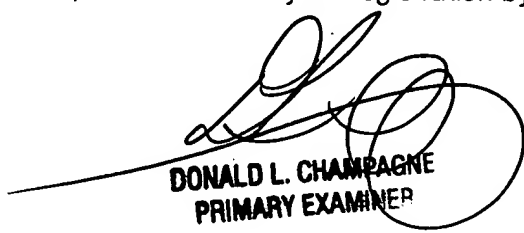
Conclusion

17. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Stokes (US Pat. 5,039,848, where the "consumable" is the money input required to buy coupons), Molbak (US005799767A) and Weinberger (US005918721A, where the consumable is the input cans).
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

24 April 2006